

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/286, 304

04/06/99

GIULIANI

J

7791-0071-25

022850 WM02/0131  
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON VA 22202

EXAMINER

POINVILLE

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

01/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/286,304

Applicant(s)

Giuliani et al

Examiner

Frantzy Poinvil

Group Art Unit  
2164



Responsive to communication(s) filed on Nov 7, 2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 10-24 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 10-24 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2164

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al (US Patent No. 5,687,322) as set forth in the prior Office action.

Applicant's representative argues that Deaton ('322) fails teach a storage means for storing incentive data. In response, the Examiner strongly disagrees with applicant's assertion because, Deaton clearly teaches providing selected coupons to customers based on a purchased item and based on a dollar amount. Clearly these coupons are recalled from memory so that an instant presentation of these coupons is made. Applicant is again referred to column 69, lines 35-46 and column 101, lines 39-59 of Deaton.

Applicant's representative then argues that Deaton does not teach means for selecting incentive data from the storage means depending upon (1) purchase of a first item (2) price of said first item (3) price for a second item since the office action does not explain why selecting incentives based upon the price of a second item would have allowed customer loyalty.

**Art Unit: 2164**

In response, Deaton clearly teaches selecting and providing coupons in response to the purchase of a first item and a price of the first item as explained in the prior Office action and found on column 69, lines 35-46 and column 101, lines 39-59 of Deaton. Deaton further discloses these teachings on column 69, line 58 to column 70, line 25. Deaton teaches these features abundantly throughout their disclosure. Deaton does not explicitly teach selecting incentives based on the price of a second item. Such would have been obvious to the skilled artisan to allow customer loyalty to that store. A customer would be more likely to purchase an item at a store knowingly that he/she is provided with a rebate/incentive/coupons to purchase that item. This is a well known marketing scheme.

Applicant then argues that selecting incentive data based upon a difference in price between the first item and the second item would not have been obvious to the skilled artisan.

In response, Deaton teaches providing coupons based on dollar purchases by customers, a first item and the price of a first item. Providing the same based on the difference in price between the first item and the second item would have been obvious to the skilled artisan for marketing purposes therefore encouraging customers to buy complementary or supplementary items. By spending more, they will obtain a greater incentive.

Applicant then argues that Deaton does not teach that the first item and the second item are competitive items. In response, Deaton clearly teaches known methods for generating coupons based on the purchase of a competitive product. Note column 69, lines 25-30 of Deaton.

**Art Unit: 2164**

As per claims 10 and 24, Deaton et al teaches a method and system for selective incentive point-of sale marketing in response to customer shopping histories. Note the abstract. The system of Deaton et al also comprises a storage means for storing incentive data and means for selecting incentive data from the storage means depending upon the purchase of a first item. Note column 69, lines 14-33. The purchase of a first item relates to the price of the first item. Deaton et al does not explicitly teach selecting incentive data based on the price of a second item. Deaton et al teaches providing incentive data based on a dollar amount and the number and type of items purchased. Note column 69, lines 35-46 and column 101, lines 39-59. It would have been also obvious to one of ordinary skill in the art at the time the invention was made to also select incentives based on the price of a second item in order to allow customer loyalty on purchasing a specific type of product as suggested by Deaton et al.

As per claims 11-13, Deaton et al discloses printing and dispensing coupons to the purchaser of the item. Note column 69, lines 14-46.

As per claim 14, Deaton et al teaches a customer may purchase one or more items. Deaton et al also teaches that their system provides inducement coupons that can be combined. Note column 74, lines 7-17 of Deaton et al. Moreover providing more than one incentive for a given purchased item is well known in the art. Auto dealers and car dealers usually give a manufacturer incentive or a cash rebate or an additional item that was an option so that a sales of an automobile may be finalized. The customer has the option to select one of the incentives.

Art Unit: 2164

Doing the same in the system of Deaton et al would have been obvious to the skilled artisan in order to make the system attractive to different types of customers.

As per claim 15, selecting incentive data based upon a difference in price between the first and the second item would have been obvious to the skilled artisan because Deaton et al teaches providing incentive data based on dollar volumes.

As per claim 16, Deaton et al also discusses providing incentives in which purchased items are competitive items. Note column 69 lines 25-30.

Claims 17-23 contain limitations addressed in claims 10-16 respectively and therefore are rejected under a similar rationale.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2164

4.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FP

28Jan01



**Frantzy Poinvil  
Primary Examiner  
Art Unit 2164**